

**REMARKS****I. Status of the Claims:**

Claims 1-19 are pending in the application.

By this Amendment, claim 19 has been canceled without prejudice or disclaimer. Claims 1, 7, and 13-18 have been amended. No new matter has been introduced by this Amendment. Entry of this amendment before examination on the merits is respectfully requested.

Upon entry of this Amendment, claims 1-18 would be pending.

**II. Rejection Under 35 U.S.C. §112, ¶1:**

Claims 1-19 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description, particularly as to the claimed inhibition means or step. To comply with the written description requirement of 35 U.S.C. §112, first paragraph, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP §2163.04. Applicant respectfully traverses the rejection of these claims, for the reasons set forth below.

Contrary to the Examiner's allegations concerning the inhibition means or step, the application as originally filed clearly supports these claim limitations at least by way of the exemplary embodiment of Fig. 5 and the accompanying description in the specification. Fig. 5 describes the operation for changing the operation mode between STB and DVC modes through operation flow in the system control circuit 18 (of terminal body 116) and an operation flow of application software on the computer 117. See Application, page In this exemplary embodiment, the specification states:

When the system control circuit 18 of the terminal body 116 receives the DVC mode request command from the computer 117

(S3), the circuit 18 checks as to whether or not the system is changeable to DVC mode (S4). When the system can not be changed to DVC mode at that time because there is a task that is currently being processed, e.g., the system is in a video telephone communication in STB mode, the system control circuit 18 sends, together with a predetermined message, a response indicating that the system can not be changed to DVC mode, to the application software on the computer 117, so that STB mode is maintained. See Application, page 21, line 17 to page 22, line 1 and Fig. 4.

As noted in the cited passage of an exemplary embodiment, the terminal body 116 through system control circuit 18, is configured so as not to allow or, in other words, inhibit a change to DVC mode if there is a task being currently processed, e.g., the system is in a video telephone communication in STB mode. Likewise, in the exemplary embodiment of Fig. 7, the terminal body 116 is configured so as not to allow or, in other words, inhibit a change to STB mode when the terminal body 116 is starting to receive a video telephone call from the opposite party in DVC mode. See Application, page 28, line 16 to page 29, line 21. Thus, the inhibition means or step, at issue, are expressly, implicitly or inherently supported in the original filed disclosure at least by way of the examples of Fig. 5 (e.g., S4-“NO”) and Fig. 7 (e.g., S52-“NO”) and their accompanying description. One of ordinary skill in the art would have recognized that the inventors were in possession of the claimed inhibition means and step, at issue, in view of the disclosure as originally filed.

### **III. Objection to the Drawings:**

The drawings have been objected to under 37 C.F.R. §1.83(a) as failing to show the inhibition means. As noted above, the inhibition means or step, at issue, are expressly, implicitly or inherently supported in the original filed disclosure at least by way of the examples of Fig. 5 (e.g., S4 -“NO”) and Fig. 7 (e.g., S52 -“NO”) and their accompanying description. Thus, at least the examples shown in Fig. 5 (e.g., S4-“NO”) and Fig. 7 (e.g., S52-“NO”) are believed to

sufficiently reflect the inhibition means or step and satisfy the requirements under 37 C.F.R. §1.83(a). Accordingly, reconsideration and withdrawal of the objection to the drawings are respectfully requested.

**IV. Rejection Under 35 U.S.C. § 103:**

Claims 1-4, 7-10 and 13-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Clapp et al. (U.S. Patent No. 6,073,192) and Rodriguez et al. (U.S. Patent No. 5,999,207) and Chivers (U.S. Patent No. 4,376,973) and Catanzaro (U.S. Patent No. 5,502,727). Claims 5-6 and 11-12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Clapp et al. (U.S. Patent No. 6,073,192) and Rodriguez et al. (U.S. Patent No. 5,999,207) and Chivers (U.S. Patent No. 4,376,973) and Catanzaro (U.S. Patent No. 5,502,727) as applied in claims above, and further in view of Kato et al. (U.S. Patent No. 5,898,824). Applicant respectfully traverses the rejection of these claims, for the reasons set forth below

Independent claims 1, 7 and 18 are directed to an arrangement involving inhibiting change from said first operation mode to said second operation mode or change from said second operation mode to said first operation mode, while communicating with said other terminal device.

As acknowledged by the Examiner, Clapp, Rodriguez and Chivers do not disclose or suggest the inhibiting feature. The Examiner alleges that Catanzaro teaches the inhibiting feature.

Catanzaro as relied upon by the Examiner shows a power switch 255 that controls the flow of audio signals from the speaker phone based on a mode, e.g., voice mode or video digital connection mode. See col. 5, lines 35-57. For example, in voice mode, the audio signals from the phone are sent to the network, across interfaces 290 and path 257. In video digital

connection mode, the audio signals are routed for processing together with video signals for subsequent transmission of both video and audio to the network. The switch 255 simply facilitates the routing of audio signals from the phone based on the operation mode, but does not inhibit “changing” from a voice mode to video mode (or vice versa) while communicating with another terminal device. Thus, Catanzaro does not disclose or suggest the inhibiting feature, as claimed.

Further, Catanzaro teaches away from the claimed inhibiting feature. As described in Catanzaro, a user can change from an analog voice mode to digital video connection mode while communicating with another party. See col. 6, lines 59- 67 and Fig. 4. Thus, one of ordinary skill in the art would not be motivated to combine the references in the manner suggested by the Examiner.

Accordingly, claims 1, 7 and 18 and their dependent claims are patentably distinguishable over the cited references, individually or in combination.

**CONCLUSION**

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and allowance of this application.

**AUTHORIZATION**

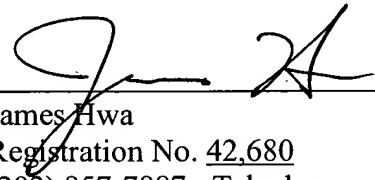
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 1232-4681.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 1232-4681.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: 9/7/05

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